

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 1-11, 25, 26 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,646,076 to Bortz ("the Bortz patent").

Claim 1 has been amended to include the limitation of claim 8. Claim 1 now recites that "the thermosetting resin includes a polar solvent".

Under 35 U.S.C. § 102, a claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1266, 1236 (Fed. Cir. 1989).

Applicants respectfully submit that the Bortz patent does not disclose or suggest a thermosetting resin including a polar solvent. The Bortz patent is directed to a friction controlling device made of fiber-reinforced polymer composite materials produced by nonwoven textile and plastics industries' materials. Although the Bortz patent describes polymer binders "processed with suitable solvents or additives and catalysts" (col. 8, lines 45-49), applicants respectfully submit that the solvents referred to in the Bortz patent are not polar solvents.

Accordingly, because of the absence of at least this claim limitation, applicants respectfully submit that claim 1, as now presented, is patentable over the Bortz patent.

Similarly, because rejected claims 2-7, 9-11, 25 and 28 depend (either directly or indirectly) from independent claim 1, applicants respectfully submit that these claims are also patentable over the Bortz patent.

Reconsideration and withdrawal of the rejection are respectfully requested.

V.

REJECTION UNDER 35 U.S.C. § 103

Claims 6, 7, and 25 stand rejected as being unpatentable over the Bortz patent in view of United States Patent No. 5,823,314 to Suzuki ("Suzuki").

As discussed above, the Bortz patent does not teach or suggest that "the thermosetting resin includes a polar solvent", as now recited in claim 1. Therefore, because rejected claims 6, 7 and 25 depend (either directly or indirectly) from independent claim 1, applicants respectfully submit that claims 6, 7 and 25 are also patentable over the Bortz patent.

With respect to the Suzuki patent, applicants respectfully submit herewith a copy of the filing receipt showing priority to French Patent Application 94 03518. The Suzuki patent is an intervening reference between the U.S. filing date and priority date (March 25, 1994) of the present application. In view of this, Suzuki is not prior art and should be removed as a basis for rejection of the claims.

Reconsideration and withdrawal of the rejection of claims 6, 7, and 25 are respectfully requested.

PATENT

DOCKET NO. 1948-4293 US1

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully requests reconsideration and allowance of this application.

AUTHORIZATION

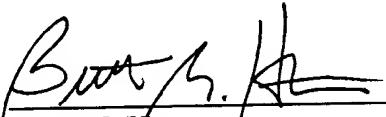
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account 13-4500, Order No. 1948-4293US1. A DUPLICATE OF THIS DOCUMENT IS ATTACHED. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,

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